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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,780	12/26/2000	Tanja Ouimet	P06910US00/BAS	3825

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EXAMINER

WALICKA, MALGORZATA A

ART UNIT PAPER NUMBER

1652

DATE MAILED: 08/28/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding:

Office Action Summary

Application No.

09/647,780

Applicant(s)

OUIMET ET AL.

Examiner

Malgorzata A. Walicka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

- Group I claim(s) 1-6, 11, 13 and 14, drawn to novel membrane protease of SEQ ID NO: 2, encoding DNA, expression vector, host cell, antibody and a method of use the enzyme in screening for its inhibitors.
- Group II claim(s) 7, drawn to a method for immunologically detecting the enzyme of SEQ ID NO: 2 in cell.
- Group III claim(s) 8 and 9, drawn to a method for detecting the expression of the polypeptide of SEQ ID NO: 2 in a cell.
- Group IV claim(s) 10, drawn to a method for detection the activity of the enzyme of SEQ ID NO: 2.
- Group V claim(s) 12, drawn to a method for detecting the enzyme of SEQ ID NO: 2, in cell or a tissue sample, using its substrate or inhibitor.
- Group VI claim(s) 1-6, 11,13 and 14, drawn to novel membrane protease of SEQ ID NO: 4, encoding DNA, expression vector, host cell, antibody and a method of use the enzyme in screening for its inhibitors.
- Group VII claim(s) 7, drawn to a method for immunologically detecting the enzyme of SEQ ID NO: 4 in cell.

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Group VIII claim(s) 8 and 9, drawn to a method for detecting the expression of the polypeptide of SEQ ID NO: 4 in a cell.

Group IX claim(s) 10, drawn to a method for detection the activity of the enzyme of SEQ ID NO: 4.

Group X claim(s) 12, drawn to a method for detecting the enzyme of SEQ ID NO: 4, in cell or a tissue sample, using its substrate or inhibitor.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical features of Group I-V is a novel membrane bound metalloprotease having amino acid sequence of SEQ ID NO: 2. The special technical feature of Group V-X is a novel membrane bound metalloprotease having amino acid sequence of SEQ ID NO: 4. The enzymes are different chemical compounds having different chemical structure. Thus, technical features of Groups I-V and VI-X are different.

The technical feature of Group II-V is the same as technical feature of Group I, but 37 CFR 1.475 does not provide for multiple products or methods within single application, therefore, unity of invention is lacking with regard to Group I - V.

The technical feature of Group VII-X is the same as technical feature of Group VI, but 37 CFR 1.475 does not provide for multiple products or methods within single application, therefore, unity of invention is lacking with regard to Group VI - X.

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For the reason indicated above the restriction is proper.


In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka, Ph.D., whose telephone number is (703) 305-7270. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D. can be reached on (703) 308-3804. The fax number for this Group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionists whose telephone number is (703) 308-0196.

Malgorzata A. Walicka, Ph.D.
Art Unit 1652
Patent Examiner


NASHAAT T. NASHED PHD.
PRIMARY EXAMINER